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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,540	05/31/2001	Miwako Doi	209249US2SRD	6767
22850	7590	01/17/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			DIVECHA, KAMAL B	
			ART UNIT	PAPER NUMBER
			2151	

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,540

Applicant(s)

DOI, MIWAKO

Examiner

KAMAL B. DIVECHA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Claims 1-16 remains cancelled and claims 17-22 are pending in this application.

Claim Objections

The claim objections made in prior Final office action have been withdrawn.

Specification

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and use the invention, i.e., failing to provide an enabling disclosure.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

The applicants have failed to provide an enabling disclosure in the detailed description of the embodiment. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in these claim.

The claim recite the limitation of “requesting a selected server to download **updated table** using one of the connection information items stored in the first memory corresponding to the selected server; storing in a second memory the **updated table** downloaded from the selected server; and retrieving from the **updated table** stored in the second memory. However the disclosure fails to describe and/or provide any indication on the process of downloading updated table, storing the updated table in the memory and retrieving from the updated table.

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The applicant described the process of downloading latest table using one of the connection information items; storing in a memory the latest table downloaded from the selected server and retrieving from the latest table stored in the second memory (applicant's specification, page 20 lines 12-27, page 22 lines 5-24).

Claim Rejections - 35 USC § 112

The claim rejections made in prior final office action have been withdrawn.

The following is a quotation of the **first paragraph of 35 U.S.C. 112**:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification.

Applicant's arguments filed September 30, 2005 have been fully considered, as per request for continued examination (RCE) filed on September 30, 2005, but they are not persuasive.

The examiner summarizes the applicant's arguments presented in the response filed on September 30, 2005 and addresses each argument individually.

As per applicant's argument, the applicant argues in substance that:

- a. As noted in the official action, Agree does not disclose or suggest downloading a table from a server to a mobile as recited in applicant's independent claims (remarks, page 10).

In response to [a.]: Examiner agrees that Agre does not disclose the process of downloading a table from a server to a mobile and introduces Alperovich to disclose the process of downloading a table from a server to a mobile (page 2 lines 9-20) and have established a proper prima facie case.

Please note that the differences in the prior art are so obvious (i.e. the process of downloading a table from a server to a mobile) that it cannot be the basis for patentability. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

b. Furthermore, Applicant's submit there is no teaching, suggestion, or motivation, either explicitly or implicitly, in either reference to combine the mobile of Agre with the table of Alperovich to arrive at applicants' invention recited in independent claims. Thus applicants submit it is only through an impermissible hindsight reconstruction of applicant's invention that the rejection of applicants' independent claims can be understood (remarks, page 11).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Alperovich with Agre is that "it would have been desirable for subscribers to be able to quickly obtain local directory information about the

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regions they are traveling (Alperovich, page 2 lines 1-5, and prior final office action page 3 lines 15-18).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

c. Even if Agre and Alperovich are combined, a telephone number input to a terminal cannot be changed to another telephone number. That is, both Agre and Alperovich fail to disclose or suggest changing an input number to a new number before dialing as recited in Applicant's original claims (remarks, page 11).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., changing an input number to a new number before dialing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, Agre and Alperovich disclose all the limitations of the subject matter claimed in the instant application. As such the rejection is maintained.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agre et al. (hereinafter Agre, U. S. Patent No. 6,073,013) in view of Alperovich (PCT/US99/15132 or Int. Pub. No.: WO 00/04734).

As per claim 17, Agre discloses a Call originating method to a mobile communication terminal, comprising: a table storing a table containing an emergency telephone number for use in a user's motherland, a plurality of additional emergency telephone numbers for use in regions other than said user's motherland and which functionally correspond to said emergency telephone number for use in a user's motherland, and respective location information identifying the region where each of said plurality of additional emergency telephone numbers is in use (col. 12 L47 to col. 13 L29 and col. 14 L21-47); storing the table in a first memory (fig. 7 item #510, col. 12 L45-50); specifying a terminals present location coordinate (col. 3 L35-40); inputting said emergency telephone number for use in a user's motherland (col. 12 L45-62); retrieving from the stored table one of said plurality of additional telephone numbers whose corresponding location information designates a region including the terminals present location coordinate and whose functionality corresponds to the inputted emergency telephone number (col. 12 L45 to

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col. 13 L10); and calling the retrieved telephone number (col. 13 L25-26), however Agre does not disclose the process of receiving a table downloaded from a server.

Alperovich, from the same field of endeavor, explicitly discloses the process of receiving a table downloaded from a server storing a table containing telephone numbers of respective emergency contact points for use in respective regions (page 2 lines 9-20).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Agre in view of Alperovich by utilizing the teachings of Alperovich in order to receive a table downloaded from a server.

One of ordinary skilled in the art would have been motivated because it is desirable for subscribers to be able to quickly obtain local directory information about the regions they are traveling (Alperovich, page 2 lines 1-5).

As per claim 18, Agre discloses the process of storing in a second memory device a plurality of connection information items corresponding to respective servers and the servers' respective location information items (fig. 4 item #220 and item #222); retrieving, from the second memory, a connection information item corresponding to one of the servers whose corresponding location information item is nearest to the terminal's present location coordinate (col. 7 L24-30); and connecting to said one the serves using the retrieved connection information item (col. 8 L15-25), however Agre does not teach the process of connecting to one of the server for the purpose of receiving the table. Alperovich teaches the process of connecting wherein connecting occurs when the mobile device is powered up (page 7 lines 9-22) and receiving the table (page 7 lines 24-28). Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Alperovich as stated

above with Agre in order to receive the table. One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 17 above.

As per claim 21, Agre discloses a call originating method applied to a mobile communication terminal communicating with one of a plurality of servers using a connection information item corresponding to the one of the servers, each of the servers being provided to one of a plurality of regions and storing a table containing an emergency telephone number for use in a user's motherland, a plurality of additional emergency telephone numbers for use in regions other than said user's motherland and which functionality correspond to said emergency telephone number for use in user's motherland, and respective location information identifying the region where each of said plurality of additional emergency telephone numbers is in use (col. 12 L47 to col. 13 L29 and col. 14 L21-47), the method comprising: storing in a first memory a plurality of connection information items corresponding to respective servers and the servers' respective location information (fig. 4 item #220, 222); specifying a terminal's present location coordinate (col. 3 L35-40); selecting one the servers, whose location information is closest to the terminals present location coordinate, based on the location information stored in the first memory (col. 7 L24-30); storing in a second memory the updated table (col. 14 L21-47); inputting the emergency telephone numbers for use in a user's motherland; retrieving, from the updated table stored in the second memory one of said plurality if additional emergency telephone numbers whose functionality corresponds to the inputted emergency telephone numbers; calling the retrieved telephone numbers (col. 12 L45 to col. 13 L29) and teaches the process of requesting a selected server wherein the server is the service provider based on one of

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the connection information (col. 7 L24-30), however Agre does not disclose the process downloading an updated table.

Alperovich, from the same field of endeavor explicitly discloses the process of downloading an updated table and storing the downloaded table (page 7 lines 24-28 and page 2 lines 18-20). Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to incorporate the teaching of Alperovich with Agre in order to download an updated table to a memory.

One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 17.

As per claims 19-20 and 22, they do not teach or further define over the limitations in claims 17-18 and 21. Therefore claims 19-20 and 22 are rejected for the same reasons as set forth in claims 17-18 and 21.

Additional References

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- i. Raith et al., U. S. Patent No. 6,073,005.
- ii. Raith et al., U. S. Patent No. 6,115,596.
- iii. Lindholm, U. S. Patent No. 6,766,159 B2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kamal Divecha
Art Unit 2151
January 5, 2006.



ZARNI MAUNG
SUPERVISORY PATENT EXAMINER